

Group V: Claims 41 and 43, drawn to a method for detecting a nucleic acid using a probe or primer; and

Group VI: Claims 42 and 44, drawn to a method for producing a nucleic acid using a probe or primer.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

Citing MPEP §§806.04 and 808.01, the Office has characterized Groups I and II as “unrelated” inventions. However, Applicants note that the MPEP describes unrelated inventions as, for example, “an article of apparel such as a shoe, and a locomotive bearing”, or “a process of painting a house and a process of boring a well.” MPEP 806.04(A). Thus, unrelated inventions, as defined by the MPEP, are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. In contrast, the invention of Group I is drawn to an “isolated polynucleotide, vector and host cell”, and the invention of Group II is drawn to an “drawn to coryneform bacterium comprising an attenuated lysR3 gene.” Applicants make no statement regarding the patentable distinctness of the inventions of Groups I and II, but note that both Groups can be reasonably be searched in the same technical field. In fact both these groups are classified in class 435. Thus the inventions of Groups I and II of the present invention do not meet the standard of “unrelatedness” of MPEP 806.04(A), discussed above, nor do they present a burden on the Office. Accordingly, Applicants respectfully submit that the Restriction is improper, and request that it be withdrawn.

In regard to Groups III-VI, the Office has characterized these groups as unrelated. Citing MPEP §§806.04 and 808.01, the Office suggests that “the methods of Groups III-VI are distinct both physically and functionally; require different process steps, regents, and parameters; and produce different products.” However, Applicants respectfully submit that the Office has merely made a conclusion, and has not provided examples/explanation to suggest that these Groups are unrelated, as alleged. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

In regard to Groups I and III-VI, the Office has characterized these groups as unrelated. Citing MPEP §§806.04 and 808.01, the Office alleges that “each of the processes of Groups III-VI do not require the product of Group I.” However, Applicants respectfully submit that the Office has not provided any explanation/examples and has made an unsupported conclusion. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

In regard to Groups II and III, the Office has characterized the relationship between these groups as product and process of use. Citing MPEP §806.05(h), the Office states that the product as claimed can be used in a materially different process such as a “recombinant process to make a polypeptide.” Applicants note that the Office has merely stated an unsupported conclusion. The Office has failed to show that the alleged “recombinant process to make a polypeptide” is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction.

Further, Applicants respectfully traverse the Requirement for Restriction on the grounds that the Office has not shown that a burden exist in searching all of the claims. Applicants respectfully point out Groups I-VI are in classified in class 435, and that

thousands of U.S. patents have issued in which many more than one class is searched, and the Office cannot reasonably assert that a burden exists in searching only one class.

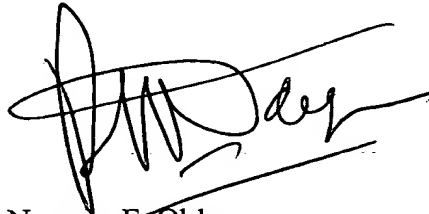
Finally, Applicants note that MPEP §821.04 states, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction. Withdrawal of the Requirement for Restriction is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Rohitha M. Jayasuriya
Registration No. 50,385



22850

PHONE: (703) 413-3000
FAX: (703) 413-2220
NFO:RMJ: